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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
07/580,246	09/10/1990	DONALD R. HUFFMAN	7913Z	5441

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EXAMINER

HENDRICKSON, STUART L

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 07/580,246

Filing Date: September 10, 1990

Appellant(s): HUFFMAN ET AL.

Mark J. Cohen
For Appellant

MAILED

JUN 03 2005

EXAMINER'S ANSWER

GROUP 1700

This is in response to the appeal brief filed 3/10/2005.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2) ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Of note is that 08/236,933 has recently been decided.

(3) ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4) ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. **The amendment filed with the Brief has been entered.**

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Art Unit: 1754

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct, noting that cancellation of claims has rendered moot the accompanying rejections thereof.

(7) *Grouping of Claims*

The rejection of claims on appeal stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is substantially correct. It appears in claim 156 that 'thin' has been changed to 'than'.

(9) *Prior Art of Record*

Kroto et al., NATURE volume 318 pg. 162 11/14/1985

Curl et al., SCIENTIFIC AMERICAN pg. 54 October 1991

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 53-72, 86, 96, 102-107, 111-114, 119, 122-132, 141-152, 154-157, 162, 165-170 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The substance of the rejection is set forth in the paper mailed 11/30/93.

Art Unit: 1754

Claims 53-73, 75, 80, 81, 86, 92, 93, 96, 102-107, 111-114, 119, 122-132, 141-157, 162, 165-170 are rejected under 35 U.S.C. 101.

The substance of this rejection is set forth in a prior Office Action, mailed on 11/30/93.

Claims 73, 75, 80, 81, 84, 89, 92, 93 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kroto et al. article in view of Curl et al. to show a state of fact.

The substance of this rejection is set forth in a prior Office Action, mailed on 11/30/93, noting that the claims reciting 'macroscopic' amounts are not rejected.

(11) *Response to Argument*

At the outset, it is noted that claim 156 may intend to refer to 'thin' layer chromatography and that the examiner will permit change thereto in a further amendment, in so far as this is necessary. With the Brief, appellants have file papers concerning proceedings of other applications, containing discussion of the term 'macroscopic'. These discussions are incorporated herein by reference.

For the reasons referred to in the above noted applications and papers, the term 'macroscopic' is deemed to lack support, despite the use of this term by independent authors to characterize the original NATURE article and the product made therein. The Declarations stating otherwise are opinion and hence are not persuasive. Merely because a material gives a colored solution does not mean that it is in amount which is a visible solid or macroscopic or crystalline. That the product gives an indicator which is visible does not mean that the material itself is visible. As an analogy, the turning of a pH indicator from clear to red does not mean that the protons themselves are visible. What Curl discusses does not make the present use of

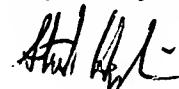
'macroscopic' supported; if anything, the inability of Curl to make a macroscopic material confirms that this is not supported.

Concerning the 101 rejection, it stands to reason that a macroscopic amount of fullerenes are made by a wood-fueled fire, given that flames- particularly from aromatics- are sooty and are black with particulates. Given what is argued by appellant throughout, especially at Brief pg. 31, visible is equated to macroscopic. Terms such as 'formed' and 'molded' does not confer patentable distinction on the materials; one generally does not know the past history of a blob of material.

Kroto does not reject claims which recite 'macroscopic' amounts, thus rendering moot many arguments. Essentially, claims are rejected as being not supported due to the term 'macroscopic' or they are rejected over art if they lack the term 'macroscopic'. There is no inconsistency.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



SLH
May 31, 2005

STUART L. HENDRICKSON
PRIMARY EXAMINER

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